

Attorney Docket No.: J2072(V)
Serial No.: 10/559,588
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Confirmation No.: 2719

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to office action notified on October 26, 2009, please enter the following Pre-Appeal Brief Request for Review on the above-identified application as follows. A Notice of Appeal is filed herewith. Because this Request is limited to five (5) pages, the arguments here do not represent all of Applicants' objections to the office action. Applicants reserve the right to raise additional arguments on appeal, including arguments not presented in this request. The Commissioner is hereby authorized to charge any additional fees, which may be required to our deposit account No. 12-1155, including all required fees under: 37 C.F.R. §1.16; 37 C.F.R. §1.17; 37 C.F.R. §1.18; C.F.R. §1.136.

Remarks/Arguments begin on page 2 of this paper.

REMARKS

Reconsideration and withdrawal of the examiner's rejections under 35 U.S.C. §§ 102 and 103 is respectfully requested in view of the following remarks. The applicant would like to thank the examiner for his time and kind cooperation in this matter.

35 USC § 102 and § 103

The examiner has maintained the rejection of claims 1-10 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GB 1 190 023. Applicants respectfully traverse this rejection.

As stated in the arguments of record, GB '023 relates to a liquid biodegradable detergent composition based on alkali metal fatty soap and generically discloses the fact that the composition may contain at least one C₈ to C₂₂ unsaturated fatty acid (see page 1, line 19).

Applicants respectfully submit that a proper prima facie case under §§ 102 or 103 has not been made out with respect to the claims at least because GB '023 does not teach or suggest castor oil or ricinoleic acid unsaturated soaps nor the specific concentration range claimed of 0.05 to 4% by wt. for these unsaturated soaps.

As stated earlier, it has been unexpectedly found by way of the present invention (see examples) that a small amount of soap made from castor oil based unsaturated fatty acids, their precursors or derivatives in a C₁₂-C₁₈ soap matrix ensures high transparency in the composition, and allows for a wider formulation window such as the higher use of sodium soaps, lower use of non-soap detergents and humectants, and use of higher molecular weight fatty acid soaps. It is clear from the present specification (see for example page 12, lines 11 to 17 and also from tables 2 and 3) that the addition of castor oil increases the transparency of the soap composition dramatically which property is required by the claims. The results from the tables indicate that such behaviour is not seen when a different unsaturated oleate soap is added to the compositions. Therefore it is specifically the castor oil which is required to improve the transparency of the present liquid/gel cleansing composition in a specified temperature range thus establishing the criticality for the selection of castor oil/ricinoleic acid soap and the claims of the present invention are not anticipated by nor rendered obvious in view of the art of record.

Applicant's respectfully submit that assuming *arguendo* a proper *prima facie* case had been set out the unexpected results disclosed in the examples is sufficient to rebut the examiner's rejection under § 103. KSR v. Teleflex, 127 S.Ct. 1727 (2007). MPEP 716.02(a). When a person of ordinary skill is faced with "a finite number of identified, predictable solutions" to a problem and pursues "the known options within his or her technical grasp," the resulting discovery "is likely the product not of innovation but of ordinary skill and common sense." KSR, 127 S. Ct. at 1742. In other cases, though, researchers can only "vary all parameters or try each of numerous possible choices until one possibly arrive[s] at a successful result, when the prior art [gives] either no indication of which parameters [are] critical or no direction as to which of many possible choices is likely to be successful." In re O'Farrell, 853 F.2d 894, 903 (Fed. Cir. 1988). In such cases, "courts should not succumb to hindsight claims of obviousness." In re Kubin, ___ F.3d ___, No. 2008-1184, slip op. at 14 (Fed. Cir. Apr. 3, 2009). Similarly, patents are not barred just because it was obvious "to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." In re O'Farrell, 853 F.2d at 903. Quoted in Procter and Gamble v. Teva Pharmaceutical, ___ F.3d ___, No. 2008-1404, slip op. at 10 (Fed. Cir. May 13, 2009).

The examiner contends that the Tables in applicant's specification are not commensurate in scope with the claimed invention since the examples are drawn to narrower compositions outside the scope of the broader claims, and that criticality cannot be established. In response, applicants respectfully submit that the claim limitations that the unsaturated fatty acid containing soap is transparent in a defined temperature range and consists essentially of castor oil and ricinoleic soaps in a specific narrow concentration range and further contains a specific subset of humectants is commensurate with the experimental showing notwithstanding the examiner's contention to the contrary assuming *arguendo* a proper *prima facie* case had been set forth.

"We feel that the unobviousness of a broader claimed range can, in certain instances, be proven by a narrower range of data. Often, one having ordinary skill in the art may be able to ascertain a trend in the exemplified data which would allow him to reasonably extend the probative value thereof. The proof, thus considered, might then be sufficient to rebut a PTO holding of *prima facie* obviousness." In re Kollman, 595 F.2d48, [**20] 56, 201 USPQ 193, 199 (CC A 1979).

Applicants respectfully submit that the specification contains several soap bar examples which compare several different polyhydric alcohol humectants and two different unsaturated fatty acid soaps which themselves contain a different distribution of alkyl chain lengths.

Moreover, the examiner has offered no facts whatsoever to show other unsaturated fatty acid soaps and polyhydric alcohol humectants disclosed in the art of record would behave differently in the claimed soap bar (In re Cescon, 474 F.2d 1331, 1334; 177 USPQ 264, 267 (CCPA 1973). Applicants respectfully submit, assuming *arguendo* that a proper *prima facie* case had been set forth, that the examiner has not carried his burden to provide a factual basis for the skilled person to expect disclosed humectants and unsaturated soaps would behave differently than those exemplified according to the analogous situation *In re Cescon*.

Furthermore, applicants respectfully submit the examiner's assertion that the claim must be limited to specific compounds disclosed in the specification is in error.

"Certainly, objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support (citations omitted). By the same token, appellant is not required to test each and every species. Rather patentability is established by a showing of unexpected superiority for representative (emph.) compounds within the scope of the appealed claims. What is representative is a factual question which is decided on a case-by-case basis." *In re Winters*, 11 USPQ 2d 1387 (Bd. Pat. App. & Interf., 1989).

Applicants respectfully reiterate, assuming *arguendo* that a proper *prima facie* case had been set out, that the testing of propylene glycol, glycerine, Peg-1500, castor soap and oleate soap satisfies the standard articulated in the cases discussed above whereby the proffered evidence of unexpected results is commensurate in scope with the claims.

The examiner has maintained the rejection of claims 1, 3-4 and 6-10 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GB 2 005 297. Applicants respectfully traverse this rejection.

Applicants respectfully submit that GB2005297 does not disclose or suggest that very low amounts of castor oil soap or salt of ricinoleic acid improve the transparency of a liquid cleansing composition because the cleansing composition of GB2005297 is specifically creamy white and not transparent. Moreover, GB 2005297 teaches away from transparent soap and is directed toward formulating a creamy white liquid soap (see page 2, line 20). Furthermore, GB2005297 does not disclose the amount or kind of unsaturated fatty acid present in the composition and it would not be obvious to the skilled person what and how much unsaturated fatty acids is required because the requirement is to produce a creamy white soap and not a transparent soap as claimed.

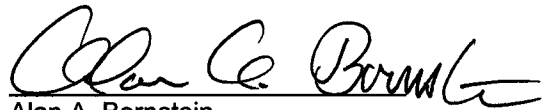
Improper citation to WO 2006/045390 (WO '390)

Referring to paragraph 11, the examiner contends that GB '023 or GB '297 teaches coconut acids and palmitic acids used in forming soaps (examples 1-6). However, there is no specific disclosure of castor oil soap or salt of ricinoleic acid or derivative thereof in either GB'023 or GB'297. The examiner has sought to remedy this deficiency by referring to WO '390. Applicant respectfully submits that the examiner has previously withdrawn the rejection of obviousness over WO '390 under 35 U.S.C. 103(a) in the office communication dated 11/03/2008 page 3, paragraph 9 and the anticipation rejection under 35 USC § 102(e) in the office communication dated April 28, 2009, paragraph 10. In view of this, the deficiencies of GB '023 or GB '297 can not be remedied in the way the examiner attempts to do so.

CONCLUSION

In light of the above remarks, applicants submit that the claims now pending in the present application are in condition for allowance. The examiner is invited to contact the undersigned if there are any questions concerning the case.

Respectfully submitted,



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